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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,474	01/28/2004	Joseph Kirk Ollis	50037.207US01	3621
27488 7590 11/20/2008 MERCHANT & GOULD (MICROSOFT) P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903				
EXAMINER				
CHANKONG, DOHIM				
ART UNIT		PAPER NUMBER		
2452				
MAIL DATE		DELIVERY MODE		
11/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/767,474

Applicant(s)

OLLIS ET AL.

Examiner

DOHM CHANKONG

Art Unit

2452

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to Applicant's amendment filed on 8/25/2008. Claims 1-3, 5-11, 14, and 16-20 are amended. Claims 1-20 are presented for further examination.
2. This action is a final rejection.

Response to Arguments

3. Applicant's argument with respect to claims 10-20 have been considered but are not persuasive. Applicant argues that Huang does not disclose selecting GAL contacts to include on the user's device that are in addition to the user's personal contacts that are already on the device. Independent claims 1, 10 and 16 have been amended to include this functionality. The claim language for this feature recites "automatically selecting global address list contacts for a user to include on the device in addition to a user's personal contacts that are already stored on the device." Claims 1, 10, and 16 also includes similar language reciting that the GAL contacts are unique from the personal contacts. Huang still teaches this functionality as it is currently written.

It is first important to note that Applicant's arguments imply that the GAL contacts are never merged with the personal contacts. However, selecting and receiving GAL contacts that are "in addition to" already stored contacts does not mean that the GAL contacts are always kept separate from the stored contacts. The aforementioned claim language does not proscribe merging the two contact lists to form a single list. According to Applicant's claim language, there are only two other features associated with the GAL contacts: (1) that they are "in addition

to" a user's personal contacts and (2) that they are unique from the personal contacts. Huang teaches parsing received emails to extract email addresses [Fig. 3d]. These extracted email addresses are then selected and processed [Fig. 3e]. Huang determines whether the extracted email addresses are unique from the addresses already stored on the user's personal address book [Fig. 3e «steps 347-355»]. Any addresses that are determined to be unique are inherently "in addition to" the contacts that are already stored in the personal address book. Where Huang differs and as Applicant's arguments point out is that Huang takes the further step of merging this extracted email addresses into the user's book whereas Applicant's invention maintains them as separate lists. Because of an additional limitation that is only present in claim 1 but not claims 10 and 16, only claim 1 can be interpreted in this manner.

Claim 1 is amended to also include a feature directed towards maintaining the user's personal contacts during a synchronization that updates the provided GAL contacts. By this claim language, Applicant has distinctly established that there are two contact lists being operated on by the invention and implicitly proscribes merging the lists into one. On the other hand, claims 10 and 16 do not have this language and therefore are not afforded the same interpretation; there is no language those claims that require maintaining two separate lists.

Additionally, claim 10 is amended to include a feature directed towards adding an GAL contact to the user's personal contacts when the GAL contact has been edited. Huang teaches this limitation as well. Huang teaches that prior art adding an extracted email address to a the personal address book, a user may edit the contact [Fig. 3e «step 353, 354»]. This step reads on the new limitation.

In sum, Applicant's arguments with respect to claims 1-9 have been considered and are persuasive. Applicant's amendment is sufficient to overcome Huang. The rejection for claims 1-9 are therefore withdrawn. However this action sets forth a new ground of rejection that is necessitated by Applicant's amendment. With respect to claims 10-20, Applicant's arguments are not persuasive and the new amendments do not overcome the Huang reference. Therefore, the rejection of claims 10-20 are maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 5-7, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwartz et al, U.S. Patent Publication NO. 2004/0135816 [“Schwartz”].

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

5. As to claim 1, Schwartz discloses a method for populating a list of GAL contacts on a device, comprising:

automatically selecting global address list (GAL) contacts for a user to include on the device in addition to user's personal contacts that are already stored on the device [0021: tracking "non-address book message targets"];

removing any duplicates from the GAL contacts to ensure that the GAL contacts are unique from the user's personal contacts [0044: separate list of new recipients - therefore the addresses in the "non-address book" are unique];

preparing the GAL contacts [0044]; and

providing the GAL contacts to the device [0044];

wherein the user's personal contacts are treated differently from the provided GAL contacts such that the user's personal contacts are maintained during a synchronization that updates the provided GAL contacts [0044 - the non-address book is updated while the user's personal address book is maintained].

6. As to claim 3, Schwartz discloses automatically selecting the global GAL contacts further comprises obtaining the GAL contacts from a user's emails including obtaining a primary addressee from each of a predetermined number of sent emails from the user [0044].

7. As to claim 5, Schwartz discloses determining when one of the GAL contacts on the device is removed by the user and when one of the GAL contacts on the device is removed by

the user preventing the removed GAL contact from being provided to the device during the synchronization [0043; removing an entry from the list implies that the entry will not be added to the personal address book].

8. As to claim 6, Schwartz discloses determining when the user edits one of the GAL contacts on the device; and when the user has edited one of the GAL contacts on the device making the one of the GAL contacts one of the personal contacts on the user's device [0044].

9. As to claim 7, Schwartz discloses limiting the number of GAL contacts provided to device [0043].

10. As to claim 9, Schwartz discloses displaying the GAL contacts along with the user's personal contacts wherein the GAL contacts are visually distinguishable from the user's personal contacts [0044].

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 10, 11, 15, 16, 19, and 20 are rejected under 35 U.S.C. §102(b) as being anticipated by Huang et al, U.S. Patent No. 5,966,714 ["Huang"].

12. As to claim 10, Huang discloses a system for populating a list of GAL contacts on a device, comprising:

a device including a communication connection, a data store, a display, and a processor that is configured to perform the following actions [*Figure 1a «item 106» | Figure 1c «item 106» | column 5 «lines 36-37»*], including:

connecting to a network using the communications connection to perform a synchronization [*column 5 «lines 17-42»*];

receiving an update list from the network containing information to update global address list (GAL) contacts that are unique from a user's personal contacts [*column 2 «lines 27-31» : a change list | column 4 «lines 5-10» : generating a subset of a large address book*] and are in addition to the user's personal contacts [*see Response to arguments | Fig. 3e «steps 347-355»*];

updating the GAL contacts [*column 4 «line 62» to column 5 «line 1» | column 6 «lines 60-64»*];

storing the updated GAL contacts in the data store [*column 4 «lines 50-54» : memory within the client device*]; and

displaying the GAL contacts on the display [*Figure 1d*]; and

when an edit is made to one of the GAL contacts on the device adding the edited GAL contact to the user's personal contacts on the device [*see Response to arguments | Fig. 3e «step 353, 354»*];

a server including a communications connection, a data store, and a processor that is configured to perform the following actions [*Figure 1c «items 127, 102»*], including:

obtaining the GAL contacts for the user [*column 6 «lines 8-12»*];

preparing an update list based on the GAL contacts in the data store on the device and the obtained GAL contacts [*column 7 «lines 26-32» | Figure 3e «item 350»*];

preparing the information from the master address book [*column 9 «lines 63-66»*]; and

providing the GAL contacts to a device over the network [*Figure 3e «item 355» | column 9 «lines 63-66»*].

13. As to claim 11, Huang discloses automatically selecting the GAL contacts further comprises obtaining the GAL contacts from the user's emails [*column 5 «line 67» to column 6 «line 7»*].

14. As to claim 15, Huang discloses displaying the GAL contacts along with the user's personal contacts [*Figure 1d*].

15. As to claim 16, Huang discloses a computer-readable storage medium including computer-executable instructions for populating a list of GAL contacts on a device, comprising:

beginning a synchronization session [*column 4 «lines 5-18»*];

automatically selecting global address list (GAL) contacts for a user that in addition to a user's personal contacts on the device and that are unique from the user's personal contacts from the user's emails [*See Response to arguments | column 4 «line 50» to column 5 «line 4»*];

receiving only a subset of the larger address book | *column 6 «lines 1-14» | Figure 3e «item 347»*
: selecting contacts based on scanning email addresses from a user's Email folders and archives
and determining whether the address is already in the user's personal address book (PAB)]; and
providing the GAL contacts to a device [*Figure 3e «item 355» | column 9 «lines 63-66»*].

16. As to claim 19, Huang discloses providing the GAL contacts to the device further comprising providing updates to the device in order to update a GAL contact store on the device [*column 4 «line 62» to column 5 «line 1» | column 6 «lines 60-64»*].

17. As to claim 20, Huang discloses maintaining a user snapshot list outside of the device that is related to the GAL contacts for the user [*Figure 1c «item 128» | column 6 «lines 37-40»* : snapshot of the highest ranked addresses stored at the host device (outside of the user's mobile device)].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 12, 14, and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Huang, in view of Kraenzel et al, U.S. Patent Publication No. 2005[0198144 ["Kraenzel"].

19. As to claims 12, 14, and 17, Huang does disclose obtaining a primary addressee from sent emails from the user [column 5 «line 67» to column 6 «line 7» | column 7 «lines 62-65» | column 9 «lines 44-67»], but does not expressly disclose scanning a predetermined number of sent emails from the user. However, the feature of specifying a number of sent emails to be retrieved and scanned was well known in the art at the time of Applicant's invention as evinced by Kraenzel.

Kraenzel is directed towards a system for managing message addressed by extracting the information from emails [abstract]. Kraenzel discloses that a user can specify the number of emails to search to extract the addressee information [Figure 3 : specifying number of messages if more than a certain number | 0060-0062]. It would have been obvious to one of ordinary skill in the art to have adapted Huang's system to include Kraenzel's user selectable filters. One would have been motivated to adapt Huang because the filters increase the amount of control that a user has over the number of messages to be scanned.

20. Claims 13 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Huang, in view of Lake, U.S. Patent No. 7,200,638.

21. As to claims 13, and 18, Huang does not expressly disclose obtaining the GAL contacts from meeting requests. However, the feature of extracting contact information from meeting requests was well known in the art at the time of Applicant's invention as evinced by Lake. Lake is directed towards a system for automatically populating a contact list [abstract]. Lake teaches

that one of the ways to accomplish this task is to extract the contacts from meeting information found in a user's calendar [*Figure 3 | column 2 «lines 6-11»*]. It would have been obvious to one of ordinary skill in the art to have adapted Huang's system to include Lake's automatic population functionality. Lake teaches that such a feature more efficiently manages a user's contact list [*column 1 «lines 51-62»*].

22. Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schwartz in view of Kraenzel.

23. As to claim 2, Schwartz discloses obtaining the GAL contacts from emails [abstract] but does not disclose obtaining the GAL contacts from other forms of communication. However, extracting contact information from a variety of communications was a well known feature in the art at the time of Applicant's invention as evidenced by Kraenzel. Kraenzel teaches obtaining contacts from phone calls, SMS or IM messages, and user meetings [*0030, 0031: discussing the application of his extraction feature in a variety of products including instant messaging, discussion forums or other multi-part communication systems*]. It would have been obvious to one of ordinary skill in the art that the forms of communication being claimed in claim 2 are contemplated by Kraenzel as multi-part communication systems. It would have been further obvious to one of ordinary skill in the art to have modified Schwartz's system with the ability to obtain contacts from a wider variety of communications as taught by Kraenzel. Such a modification substantially increases the number of contacts that may be included in the contact list.

24. Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schwartz, in view of Lake.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

25. As to claim 4, Schwartz does not expressly disclose obtaining the GAL contacts from meeting requests. However, the feature of extracting contact information from meeting requests was well known in the art at the time of Applicant's invention as evidenced by Lake. Lake is directed towards a system for automatically populating a contact list [*abstract*]. Lake teaches

that one of the ways to accomplish this task is to extract the contacts from meeting information found in a user's calendar [*Figure 3 | column 2 «lines 6-11»*]. It would have been obvious to one of ordinary skill in the art to have adapted Schwartz's system to include Lake's automatic population functionality. Lake teaches that such a feature more efficiently manages a user's contact list [*column 1 «lines 51-62»*].

26. Claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schwartz in view of Calder et al, U.S. Patent Publication No. 2001|0034244 ["Calder"].

27. As to claim 8, Schwartz does disclose maintaining a snapshot list that excludes the user's personal contacts [0044] but does not disclose maintaining a snapshot list outside of the device. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by Calder. Calder discloses maintaining several snapshot lists outside of the user's device [*Fig. 4 | 0054*: disclosing multiple fone lists that may be individually downloaded to the handset]. Calder discloses the benefit of this feature allows a user to maintain a variety of contact lists for different purposes and downloading them as needed [0055: a list for contacts from a first country and a list for contacts from a second country]. Therefore, it would have been obvious to one of ordinary skill in the art to have modified Schwartz to include the snapshot list feature as taught by Calder.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571.272.3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Examiner, Art Unit 2452